

## REMARKS

This Amendment is submitted in reply to the final Office Action mailed on September 11, 2006. No fee is due in connection with this Amendment. The Director is authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112703-306 on the account statement.

Claims 1, 4-11, 14-16, 18-20 and 27-33 are pending in this application. Claims 2-3, 12-13, 17 and 21-26 were previously canceled or withdrawn. In the Office Action, Claim 5 has been objected to and Claims 1, 4-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. §103. In response, Claims 1, 11 and 32 have been amended, and Claim 5 has been canceled. In view of the amendments and/or for the reasons set forth below, Applicants respectfully submit that the rejection should be withdrawn.

In the Office Action, Claim 5 has been objected to. In response, Applicants have canceled Claim 5 without prejudice or disclaimer. Applicants have amended Claim 32 to correct informalities.

In the Office Action, Claims 1, 4-11, 14-16, 18-20 and 27-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,372,824 to Record et al. ("*Record*") in view of U.S. Patent 8,645 to Sturtz ("*Sturtz*"). Claims 1, 4-10, 27-31 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,645,662 to Nakashima et al. ("*Nakashima*") in view of *Sturtz*. Applicants believe these rejections are improper and respectfully traverse them for at least the reasons set forth below.

Applicants have amended Claims 1 and 11 to recite specific heating agents. Amended Claims 1 and 11 recite, in part, a heating agent chosen from the group consisting of capsicum oleoresin, capsaicin, piperine, gingerol, shoagol, cinnamic aldehyde, ginger oleoresin, cinnamon oleoresin, and cassia oleoresin, black pepper oleoresin, pepper oleoresin and combinations thereof. The amendment is supported in the specification, for example, at page 3, lines 3-13. In contrast, Applicants also respectfully submit that there is no motivation to combine certain cited references and, even if combinable, all of the claimed elements are not taught or suggested by the cited references.

*Record* and *Sturtz* fail to disclose or suggest a heating agent chosen from the group consisting of: capsicum oleoresin, capsaicin, piperine, gingerol, shoagol, cinnamic aldehyde,

ginger oleoresin, cinnamon oleoresin, and cassia oleoresin, black pepper oleoresin, pepper oleoresin and combinations thereof as required, in part, by Claims 1 and 11. *Record* and *Sturtz* fail to disclose the step of adding Erospicata oil and a cooling agent to a consumable product as required, in part, by Claims 27 and 32-33.

Applicants respectfully submit that there is no motivation to combine *Nakashima* and *Sturtz* to arrive at the present claims. For example, *Nakashima* is directed toward an oral composition for preventing and remedying dentinal hypersensitivity. To effectively reduce sensitivity a soluble aluminum compound is used for constriction or occlusion of tubular orifices. However, the soluble aluminum compound causes a metallic and astringent taste to be incorporated into the oral composition. To reduce this metallic and astringent taste, *Nakashima* explicitly teaches incorporating the oral composition with 1-menthol as a flavor agent. See, *Nakashima*, col. 8, lines 11-14. Moreover, *Nakashima* teaches away from *Sturtz* by encouraging incorporation of 1-menthol as a flavor where the amount of 1-menthol can be as much as 10% by weight. See, *Nakashima*, column 8, lines 30-35. In contrast, *Sturtz* is directed to a low menthol mint plant for producing an oil wherein menthol is substantially absent from the oil. See, *Sturtz*, col. 2, lines 29-32. Therefore, there exists no motivation to combine the cited references to arrive at the present claims.

Applicants respectfully submit that the Patent Office has improperly applied hindsight reasoning by selectively piecing together teachings of each of the references in an attempt to recreate what the claimed invention discloses. As the Federal Circuit explained, “the mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-17 (Fed. Cir. 1992). Moreover, one cannot use “hindsight reconstruction to pick and choose among isolated disclosures in the prior art” to re-create the claimed invention. *In re Fine*, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988).

Applicants also respectfully submit that, even if combinable, all of the claimed elements are not taught or suggested by *Nakashima* and *Sturtz*. *Nakashima* and *Sturtz* fail to disclose or suggest heating agent chosen from the group consisting of capsicum oleoresin, capsaicin, piperine, gingerol, shoagol, cinnamic aldehyde, ginger oleoresin, cinnamon oleoresin, and cassia oleoresin, black pepper oleoresin, pepper oleoresin and combinations thereof as required, in part, by Claims 1 and 11. Further, *Nakashima* and *Sturtz* fail to disclose the step of adding Erospicata

oil and a cooling agent to a consumable product as required, in part, by Claims 27 and 32-33. In fact, *Nakashima* teaches away from the present invention by encouraging incorporation of 1-menthol as a flavor where the amount of 1-menthol can be as much as 10% by weight. Specifically, a preferred embodiment of *Nakashima* incorporates 1-menthol as a flavor to reduce the metallic taste and astringent taste of a soluble aluminum compound, as discussed above. In contrast, in embodiments of the present invention, Erospicata is used specifically for its low, or substantially absent, 1-menthol content and high menthone content.

For at least the reasons discussed above, the combinations of *Record* and/or *Nakashima* in view of *Sturtz* are improper or fail to disclose or suggest every element of the present claims and thus fail to render the claimed subject matter obvious.

Accordingly, Applicants respectfully request that the obviousness rejections with respect to Claims 1, 4, 6-11, 14-16, 18-20 and 27-33 be reconsidered and the rejections be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

~~BELL, BOYD & LLOYD LLC~~

BY 

Robert M. Barrett  
Reg. No. 30,142  
Customer No.: 29156

Dated: December 11, 2006